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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,798	12/29/2005	Toru Maeda	070456-0098	8704
20277 7590 09/17/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
HARRIS, GARY D				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
09/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/562,798

Applicant(s)

MAEDA ET AL.

Examiner

GARY D. HARRIS

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 7/25/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/14/2008 has been entered.

Response to Arguments

Applicant's arguments filed 8/14/2008 have been fully considered but they are not persuasive. Applicant argues that the newly added limitation of the soft magnetic material having an absolute value of heat generated is considered to be a material property.

Additionally, the infiltration of oxygen and carbon (the gettering effect) is prevented, would necessarily be an inherent feature of Moorhead. The lower film surrounding a surface of each metal magnetic particle could be interpreted as an oxide layer, atmospheric considerations including dust, oxygen. Moorhead may be unaware of the improvement in minimizing the increase in impurities however, the claimed properties are deemed to be necessarily/inherent to the structure in the prior art since the Moorhead '722 reference teaches an invention with a substantially similar structure and

chemical composition as the claimed invention. Products of identical structure and composition cannot have mutually exclusive properties. The burden is on the applicants to prove otherwise.

For convenience the rejection is substantially repeated below:

Claim Rejections - 35 USC § 102 / 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 9-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moorhead et al. US 5,935,722.

As to Claim 1 & 9, Moorhead '722 discloses the use of multilayered soft magnetic materials including ferrous and nonferrous alloys (Col. 1, Line 25-67) and a preferable magnetic alloy when a composite is to be used for a magnetic core (Col. 3, Line 41-43). Additionally, an insulation layer which may consist of an oxide layer (oxygen) on the metal plus an organic adhesive (carbon) (Col. 2, Line 4-12). Moorhead '722 does not disclose affinities for nonferrous and/or ferrous metals. However, these properties are necessarily inherent because the applicants and Moorhead '722 teach virtually identical structures with similar materials. Moorhead '722 recognizes that the metal may consist of an oxide completely surrounding the powder (Col. 2, Line 7-8), the attractive nature of such protective layers on a core structure (Col. 3, Line 55-58), the use and densification of interlaminar insulation layers from ceramic, glass, glass-ceramic or mixture (Col. 4, Line 22-26) and the use of a plastic coating on the oxide layer (Col. 10, Line 9-17). Because these materials are densified utilizing HIP (hot isostatic pressing) similar to applicant's pressure-forming at temperatures not less than 500C they would necessarily be expected to have similar affinities. One of ordinary skill would expect the same affinities as similar materials are treated by a similar process. Examiner, interprets that Moorhead would necessarily have an absolute value of heat generated similar to applicant.

Alternatively, a soft magnetic material comprising a plurality of magnetic particles would be obvious to one of ordinary skill in the art.

As to Claim 2 & 10, Moorhead '722 discloses the use of, chromium, vanadium, and nickel based titanium alloys (Inconel) (Col. 5, Line 8-16) and aluminum (Col. 5, Line 54-63).

As to Claim 4 & 12, Moorhead '722 discloses a low carbon iron silicone steel (Col. 1, Line 50-54) and the use of zirconium (Col. 5, Line 41-54).

As to Claim 6 & 14, Moorhead '722 discloses chemically treating metal particles to produce an insulating oxide layer and the use of polymers in dust cores (Col. 10, Line 8-25).

As to Claim 7 & 15, Moorhead '722 discloses the use of organic adhesives (polymers) including epoxies and polyimides (Col. 2, Line 48-54).

Claims 3, 5, 11, & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moorhead et al. US 5,935,722 as applied to claims above, and further in view of Ochiai et al. US 4,919,734.

As to Claim 3 & 11, Moorhead '722 discloses the oxide layer but does not cite the particular thicknesses. However, Ochiai '734 discloses that as the particles are reduced an oxide layer of several ten's of nanometers is formed on the surface of each particle (Col. 3, Line 4-8).

As to Claim 5 & 13, Moorhead '722 discloses a metal alkoxide and/or its decomposition film on the surface magnetic powder thickness of the insulation layer is 10 microns or less (Col. 7, Line 35-40).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY D. HARRIS whose telephone number is (571)272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith D. Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary D. Harris/
Examiner, Art Unit 1794

/Holly Rickman/
Primary Examiner, Art Unit 1794